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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

VU, NGOC K

ART UNIT PAPER NUMBER

2623

DATE MAILED: 09/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/608,819

Applicant(s)

KRAPF, RUSSELL M.

Examiner

Ngoc K. Vu

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-18 and 20-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-18, and 20-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

1. Applicant's arguments filed 6/26/2006 with respect to claims 1-4, 6-18 and 20-27 have been considered but not persuasive.

With respect to claim 1, applicant argues that Corvin does not disclose or suggest that the selected promotions correspond to previously locally stored programs. This argument is not persuasive.

Corvin clearly discloses that a processor selects a program, a promotion and causes both the selected program and promotion to be recorded on storage media or storage unit that may be located locally at or near a user's television viewing equipment. The processor may select a promotion to record based on specific content of the selected program. For example, when a program with specific content is being recorded, the processor may select a promotion corresponding to the content of a program that is being recorded. (See 0023, 0026, 0027, 0029, 0031). In other words, the selected promotion corresponds to the recorded program.

Furthermore, Corvin discloses that a promotion may be a movie preview that may be recorded at the beginning of a program. The promotion may then be displayed to the user when the user plays the recorded program. (See 0006). From this view, the selected movie preview or the selected promotion is displayed to entice the viewer to selectively watch the recorded program.

Accordingly, Corvin discloses that the promotion content (the movie preview or promotion) is displayed to entice the viewer to select for viewing previously locally stored premium content (e.g., displaying the movie preview is to attract the viewer to select for viewing content of movie/program that is previously stored/recorded in the local storage) associated with the selected promotion content (the previously locally recorded program/movie associates with

the selected movie preview or promotion since the selected movie preview or promotion is recorded based on specific content of the program) with respect to the context of claim 1.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant further asserts "For reasons similar to those described above with respect to claim 1, claim 12 includes limitations not taught or suggest by the combination of Corvin in view of Takahashi." Accordingly, the above responses presented regarding claim 1 is also applicable to claim 12.

Thus, claims 1-4, 6-18, and 20-27 are not in condition for allowance. The rejections of claims 1-4, 6-18, and 20-27 are therefore maintained.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 6, 10-12, 14-18, and 20-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Corvin et al. (US 20010029610 A1) in view of Takahashi et al. (US 20020056099 A1).

Regarding claim 1, Corvin discloses a video system (see figures 1-2), comprising:
an input port (220) configured to receive video data from a headend (110), the video data including a plurality of premium contents (i.e., programs) (see figure 2; 0037);

an output port (within 260) configured to couple to a video display (225) for displaying video data selected by a viewer (see figure 2);

a personal video recorder (260 can be a device that is capable of electronically storing signal/data) configured to locally store premium content from the plurality of premium contents (see 0038-0039);

a local storage device (260) (see figure 2); and

a promotion module (270) (see figure 2) configured to select one of the promotion content, to cause the selected at least one preferred promotion content to be stored on the local storage device (260), and to cause the selected at least one preferred promotion content to be retrieved from the local storage device (260) and displayed to entice the viewer to select for viewing previously locally stored premium content associated with the selected at least one preferred promotion content (for example, displaying promote content as a movie preview is to attract the viewer to select for viewing content of movie that is previously stored in storage 260 – see 0006, 0026-0029).

Corvin does not explicitly teach a preference engine configured to track viewer selections of the video data and to create a viewer profile representing viewing preferences of a viewer. However, Takahashi teaches that section 68 stores user profiles and the viewing history of programs viewed by the user. The user profiles are created by allowing the user to input own age, sex, and other profiles (see 0088-0089). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Corvin by tracking viewer selections of the video data and to create a viewer profile representing viewing preferences of a viewer as taught by Takahashi to effectively select a program suited to the taste of the user.

Regarding claim 2, the combined system of Corvin and Takahashi comprises a set-top box configured to receive video data (Takahashi: within receiver 5 – see figures 1 & 4; Corvin: see 0035).

Regarding claims 3 and 4, the combined system of Corvin and Takahashi teaches that the plurality of premium contents received from the headend includes a plurality of conditional access video contents provided through a pay-per-view service (PPV program) (see Takahashi: 0041).

Regarding claim 6, the combined system of Corvin and Takahashi teaches that the promotion module causes display of the selected at least one preferred promotion content as program reviews (see Takahashi: figure 7; Corvin: 0006).

Regarding claim 10, the combined system of Corvin and Takahashi teaches that the promotion module is configured to cause a plurality of sets of data to be stored on the on the local storage device (260 – see Corvin: figure 2, 0027-0029, 0038), each set of data including a viewer profile and at least one preferred promotion content associated with the viewer profile (see Takahashi: 0088-0089 and figure 2).

Regarding claim 11, the combined system of Corvin and Takahashi teaches that the promotion module uses the viewer profiles to select a set of sets of data from the plurality of sets of data upon determining which viewer is likely to watch at a given day and time (for instance, based on viewing history from the viewer profile to select a promotion program to be watched at a given day and time, e.g., October 24 and 21:00-23:00 – see Takahashi: figure 7; 0088-0089).

Regarding claim 12, Corvin discloses a method of operating a video system that receives video data that includes a plurality of premium contents (programs), the method comprising:

locally storing the identified premium content from the plurality of premium contents (see 0027);

selecting a promotion content associated with the identified, locally stored premium content (0026);

storing the selected promotion content on a local storage device (260) (see 0027-0029); and retrieving the selected promotion content from the local storage device (260) and displaying the selected promotion content to entice the viewer to watch the identified, locally stored premium content (for example, displaying promote content as a movie preview is to attract the viewer to select for viewing content of movie that is previously stored in storage 260 – see 0006, 0026-0029).

Corvin does not teach creating a viewer profile representing viewing preferences of a viewer and identifying premium content from the plurality of premium contents consistent with the viewer profile. However, Takahashi teaches that section 68 stores user profiles, and the user profiles are created by allowing the user to input own age, sex, and other profiles. The system uses user profiles for specifying the ordinary program suited to the taste of the user (see 0088-0089). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Corvin by creating a viewer profile representing viewing preferences of a viewer and identifying ordinary program contents consistent with the viewer profile as taught by Takahashi to effectively select a program suited to the taste of the user.

Regarding claim 14, Corvin teaches displaying the identified, locally stored premium content corresponding to the displayed selected promotion content upon the viewer selecting the displayed selected promotion content (at step 340 - see 0029, 0039).

Regarding claim **15**, the combined system of Corvin and Takahashi teaches creating a plurality of viewer profiles, each viewer profile representing viewing preferences of a viewer and including at least one preferred promotion content selected in accordance with the viewing preferences of the viewer (see Takahashi: 0088-0089).

Regarding claim **16**, the combined system of Corvin and Takahashi teaches selecting a viewer profile from the plurality of viewer profiles upon which viewer is likely to watch at a given day and time using the viewing preferences (for instance, based on viewing history from a viewer profile to select a promotion program to be watched at a given day and time, e.g., October 24 and 21:00-23:00 – see Takahashi: figure 7; 0088-0089).

Regarding claims **17 and 18**, the combined system of Corvin and Takahashi teaches that the plurality of premium contents received from the headend includes a plurality of conditional access video contents provided through a pay-per-view service (PPV program) (see Takahashi: 0041).

Regarding claim **20**, the combined system of Corvin and Takahashi teaches scrambling the at least one conditional access video content (scrambling a program) prior to locally storing it (see Takahashi: 0054, 0059).

Regarding claims **21 and 22**, the combined system of Corvin and Takahashi teaches descrambling the scrambled program upon fulfillment of a condition for access or payment of a fee (see Takahashi: 0059 and 0041).

Regarding claim **23**, the combined system of Corvin and Takahashi teaches that the promotion module causes display of the selected at least one preferred promotion content as program reviews (see Takahashi: figure 7; Corvin: 0006).

Regarding claim **24**, Takahashi as modified by Corvin teaches that the VCR comprises the local storage device (see Corvin: 0038).

Regarding claims **25 and 27**, Corvin further teaches storing the selected promotion data in a local storage such as a disk drive (see 0039).

Regarding claim **26**, Corvin teaches recording a promotion data in a storage unit such as a VCR located locally at or near a user's television viewing equipment (see 0038-0039).

4. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Corvin et al. (US 20010029610 A1) in view of Takahashi et al. (US 20020056099 A1) and further in view of Ryan (US 6,590,979 B1).

Regarding claim **7**, the combined system of Corvin and Takahashi teaches that a first module (at headend 1) configured to scramble at least one of the conditional access video contents received from the headend (see Takahashi: 0041 and 0054). Corvin and Takahashi fail to teach that the personal video recorder locally stores the at least scrambled conditional access video content. However, Ryan discloses that it is possible to record a scrambled video signal on a VCR and replay it later for descrambling without incurring significant extra signal degradation (see col. 3, lines 10-15). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Corvin and Takahashi by recording a scrambled video signal on a VCR and replay it later for descrambling without incurring significant extra signal degradation as disclosed by Ryan for security purpose.

Regarding claims **8 and 9**, the combined system of Takahashi and Corvin teaches a second module (i.e., demux 32) configured to de-scramble at least one locally stored scrambled conditional access video content upon fulfillment of a condition for access or payment of a fee (see Takahashi: 0041, 0059, 0060).

5. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Corvin et al. (US 20010029610 A1) in view of Takahashi et al. (US 20020056099 A1) and further in view of Proehl et al. (US 2003/0131356 A1).

Regarding claim 13, Corvin teaches displaying the selected promotion content but does not explicitly teaches that displaying the selected promotion content occurs upon determined that the viewer is watching video data displayed on a video display. However, Proehl shows displaying a message for promoting program "Mad About You" when user is watching video data displayed on screen as illustrated in figure 11 (see figure 11). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the modified system of Corvin and Takahashi by displaying the selected promotion content occurs upon determined that the viewer is watching video data displayed on a video display as taught by Proehl in order to catch user attention for promoting a program effectively.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc K. Vu whose telephone number is 571-272-7306. The examiner can normally be reached on Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ngoc K. Vu
Primary Examiner
Art Unit 2623

September 15, 2006